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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,453	05/29/2002	Peter Charles Summersell	SUMMERSELL=1	6926
1444	7590	06/03/2005	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/031,453		SUMMERSELL, PETER CHARLES	
	<b>Examiner</b>		<b>Art Unit</b>	
	Michael Thaler		3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 25-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/7/02</u> . | 6) <input type="checkbox"/> Other: _____  |

Applicant's election with traverse of group I in the reply filed on April 6, 2005 is acknowledged. The traversal is on the ground(s) that the claims of Groups I and II share the same or corresponding special technical features, namely the features recited in claim 1. This is not found persuasive because the term "special technical features" is defined in PCT rule 13.2 as meaning those features that define a contribution which each of the inventions makes over the prior art (M.P.E.P. 1850). Since the features recited in claim 1 do not define a contribution over the prior art, as evidenced by the rejection of claim 1 under 35 U.S.C. 102(b) below, the features of claim 1 are not "special technical features" as defined by PCT rule 13.2. The requirement is still deemed proper and is therefore made FINAL.

Claims 25-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 6, 2005.

The disclosure is objected to because of the following informalities: On page 8, line 14, "7 and 8" should be "6 and 7". Reference numeral 30 is absent from the drawing. On page 8, line 22, "Figure 9" is incorrect since figure 9 is not

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present in this application. Appropriate correction is required.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the shielding means defined in claim 14 (and described on page 8, lines 16-18 as a sheath) as well as the probe defined in claim 20 (and described on page 9, lines 4-12) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin

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as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Anchor 30 is not seen in any of the drawings. Therefore, it is unclear what the shape and exact location of the anchor is and how it is secured within slot 14 as described on page 9, lines 23-28. Further, it is unclear where the edge of blade 29 is and in what direction it is oriented since no edge is seen in figure 7. Figure 6 appears to be inaccurate since the wide member just above the distal end of the lead line for reference numeral 29 is not seen

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in figure 6. Even though a portion of this member may be hidden from view in figure 6 (due to the rotation of knife 24 90 degrees from its orientation in figure 7), it appears that the left and right edges of this member should be seen in figure 6 since the member appears wide in figure 7. Thus, the shape of this wide member is not clear. It is unclear where the "inner rim" of the cutting device is (as defined in claim 12, as well as claim 10) and how the separate cutting means is attached to the inner rim (as defined in claim 12).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The meaning of "boss clamp" is unclear.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilbert (WO 93/12725). Gilbert discloses cannula 100 including elongate body 110 having an open proximal end 112 and an open distal end 111 and first and second lip portions 117, 118 defining slot 116.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (WO 93/12725). Gilbert fails to disclose the lipped portions made from a relatively more resilient material than that of the material of the remainder of the cannula. However, it is old and well known to form tissue contacting portions of surgical devices more resilient than other portions in order to obtain the advantage of, for example, insuring that tissue is not damaged by the tissue contacting portions of the device. It would have been obvious to make the lipped portions of the Gilbert device of a relatively more

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resilient material than that of the material of the remainder of the cannula so that it too would have this advantage.

Claims 8-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (WO 93/12725) in view of Mirza (5,366,465). Gilbert fails to disclose 1) an obturator and 2) a cutting device having a portion adapted for insertion into the slot of the cannula. However, Mirza teaches that an obturator 28 should be inserted into a cannula 24 apparently in order to obtain the advantage of facilitating the insertion of the cannula into the body (col. 6, lines 42-52 and col. 8, lines 18-24). It would have been obvious to use an obturator with the Gilbert cannula so that it too would have this advantage. Mirza also teaches that a cutting device 60 inserted into a cannula should have a portion (top of 60) inserted into the slot of the cannula 24 apparently in order to obtain the advantage of guiding the movement of the cutting device (col. 7, lines 29-41). It would have been obvious to include such a cutting portion in the Gilbert device so that it too would have this advantage. As to claim 9, Mirza fails to disclose an angled handle on the cutting device. However, it is old and well known to provide an angled handle in a surgical device in order to obtain the advantage of making the device more comfortable to use. It would have been obvious to make the handle of the Mirza



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cutting device angled so that it too would have this advantage. As to claim 10, the curved shape of the cutting device 62 of Mirza is "hook-like" as broadly claimed since it resembles a curved hook. As to claim 15, the Mirza cutting means is retractable since it can be pulled toward the surgeon. As to claim 17, Mirza discloses rib portion 30. As to claims 21-24, Gilbert fails to disclose the claimed stabilizing means. However, it is old and well known to use a clamp to stabilize a surgical instrument so that it does not have to be continually manually held. It would have been obvious to use a clamp to stabilize the Gilbert cannula so that it too would have this advantage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

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mht  
6/1/05

A handwritten signature in black ink, appearing to read 'Michael Thaler', written in a cursive style.

MICHAEL THALER  
PRIMARY EXAMINER  
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